

R E M A R K S

Claims 1-26 are currently pending in the present application. In the instant Office Action, the Examiner has raised a single rejection:

Claims 1-26 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Tao (U.S. Patent No. 6,284,007), in view of Sinwald (U.S. Patent No. 5,753,015) and T1-food.

Applicants hereby amend Claims 13 and 19, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader Claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

The Claims Are Patentable Over Tao In View of Sinwald and T1-food

The Examiner has rejected Claims 1-26 under 35 U.S.C. §103(a), as allegedly unpatentable over Tao (U.S. Patent No. 6,284,007), in view of Sinwald (U.S. Patent No. 5,753,015) and T1-food stating:

Tao teaches a vegetable lipid-based composition and candle comprising fully hydrogenated triglycerides and free fatty acids and paraffin wax (see col., lines 50-59: col. 2, lines 49-64). The free fatty acid and triglycerides are preferably saturated (see col. 3, lines 1-2). The composition contains a free fatty acid/triglyceride mixture in a ratio from 1-99% triglycerides and from 1 to 99% fatty acid (see Example 5).

Tao also teaches compositions wherein no fatty acid is present (Example 1). Tao teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Tao differs from the claims in that he does not specifically teach the claimed IV. However it would be reasonable to expect that the triglycerides of Tao would possess the claimed IV because Tao teaches that the oils are fully hydrogenated and Sinwald and T1-food teach that fully hydrogenated vegetable oils have IV from 10 to perhaps as low as 0 (see Sinwald, col. 1-3, T1-food, type PV and SS fully hydrogenated oils). ...

In the second aspect, Tao differs from the claims in that he does not specifically teach all of the claimed proportions of triglyceride, paraffin and stearic acid. However, it is not inventive to determine these result effective variables through routine experimentation. This would especially hold true since Tao is not limited to

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

the amount of paraffin and triglyceride/fatty acid mixture that is present in the composition. ...

Applicants respectfully disagree with this rejection. Nonetheless, Applicants have amended Claims 13 and 19, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader Claims in one or more future application(s). In particular, Applicants have amended Claims 13 and 19 to recite "greater than 50% by weight paraffin." Abundant support for this amendment can be found in the Specification as filed, including for example candles of Tables II and III.

Additionally, the Examiner is reminded that a *prima facie* case of obviousness requires: (a) some suggestion or motivation (in either the references themselves or in the knowledge of one of ordinary skill in the art) to combine the reference teachings, (b) a reasonable expectation of success, and (c) a teaching or suggestion of all claim limitations (MPEP, 2143). In addition, to rely on reference under 35 USC 103, it must be analogous prior art. Applicants respectfully submit the Examiner has both inappropriately relied on nonanalogous prior art, as well as having failed to establish each of the three elements of a *prima facie* case of obviousness. In addressing this rejection, Applicants largely focus on independent Claims 1, 13, 18, and 19, since non-obviousness of an independent claim necessarily leads to non-obviousness of claims dependent therefrom. Applicants respectfully point out that the claimed invention is directed to candles or candle compositions with specific Iodine Value and functional limitations, and specific paraffin content limitations (greater than 50-51% by weight paraffin).

Specifically, "[i]n order to rely on a reference as a basis for a rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."² As is evident from both the title and abstract of the instant application, Applicant's invention is primarily directed to producing low-soot and/or non-soot candles that contain paraffin wax (*See*, Specification, page 1, at lines 19-20). Similarly, the title and abstract of Tao indicate that this patent is directed to the production of candles comprising a

² MPEP 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

vegetable lipid. However, in stark contrast Sinwald is directed to the production of improved crayons from soybean oil. In particular, the Background of Sinwald indicates that the patent is directed to producing soybean oil crayons which were less brittle, less prone to breakage, more intense in color lay down, more fluid as a molten composition and more easily released from the mold upon cooling (*See*, Column 1, beginning at line 42 and ending at Column 2, line 3). Finally, Tl-food is directed at producing "food additives, food ingredients, seasonings, cooking materials etc." (*See*, Tl-food mission statement from web site attached herein as Tab 1). Thus, Applicants assert that both Sinwald and Tl-food are nonanalogous prior art which cannot be relied upon to support an obviousness rejection.

(a) No Suggestion or Motivation to Combine the References

The Examiner is also reminded that the mere fact that the references can be combined does not render the resultant modification obvious, unless the prior art also suggests the desirability of the modification.³ In the first place, Tao (of U.S. **class 44/275**) is essentially concerned with **candle** preparations which utilize "renewable resources while minimizing or eliminating use of petrochemical-derived products" (*See*, column 1, at lines 44-46). In the second place, Sinwald (of U.S. **class 106/31.34**) is essentially concerned with the commercial-scale production of improved soybean **crayons** (*See*, column 2, at lines 22-31). Thirdly, the Tl-food web site pages consist of a product list for **food** additives, and two brief specification sheets for *monoglycerides* of fully-hydrogenated vegetable oil. Applicants assert that since Tao, Sinwald and Tl-food are directed to different products (*i.e.*, candles, crayons, and food additives) and hence at solving distinct problems, the requisite motivation to combine the references is lacking.

(b) No Reasonable Expectation of Success

Applicants submit that the Examiner has simply set forth an argument that it would be "obvious to try" to develop the presently claimed invention. However, this is a standard which has been thoroughly discredited. "Indeed, an obviousness rejection is inappropriate, where the prior art [gives] either no indication of which parameters [are] critical or no

³ *See, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

direction as to which of many possible choices is likely to be successful."⁴ As indicated above, the Examiner admitted that Tao does not teach compositions comprising the claimed IV range (*e.g.*, IV of 12.5 or less) or compositions comprising the claimed proportions of paraffin, triglycerides and fatty acids (*e.g.*, greater than 50% paraffin). In fact, the totality of Tao's disclosure is directed at producing compositions comprising more lipid than paraffin. Specifically, Tao recites "the invention relates to a vegetable-lipid based composition including a vegetable lipid component and a petroleum wax wherein the composition contains a greater concentration of the vegetable lipid component than the petroleum wax (*See*, Column 1, at lines 6-10). Furthermore, neither Sinwald nor Tl-food teach compositions comprising any petroleum wax (let alone candle compositions of this type).

However, the claimed invention is expected to yield compositions with more favorable-economics, because these compositions comprise a greater amount of the less-expensive paraffin component, than the more-expensive fatty material component. Specifically, Applicants teach "... it would be highly desirable to be able to produce a candle that contains paraffin (due to its wide acceptance, *low-cost* and familiarity in the industry, yet does not produce soot or is substantially non-sooting" (*See*, Specification, page 3, at lines 1-5, *emphasis added*). Thus, Applicants disagree with the Examiner's assertion that "Tao's preferred embodiment establishes a case of obviousness because a *prima facie* case of obviousness exist[s] where the claimed ranges and the prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties" (Office Action, page 4). As Applicants candle compositions contain more paraffin than the candle compositions prepared by combining Tao, Sinwald and Tl-food, Applicants candle compositions would not be expected to have the same cost and yet be low-sooting or non-sooting.

⁴ Quoting *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 [Fed. Cir. 1988], *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 10 USPQ2d 1843, 1845 [Fed. Cir. 1989].

(c) All Claim Limitations are neither Taught nor Suggested

The Examiner is also reminded that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art."⁵ Specifically, Claims 1, 13, 18, and 19, require greater than 50%-51% by weight paraffin. Importantly, both Sinwald and T1-food *fail to teach* compositions comprising even 1% paraffin. Moreover, in contrast to the Examiner's assertion that Tao is not limited to the amount of the paraffin, Tao *expressly teaches* limitations to the amount of the paraffin present in the triglyceride/fatty acid mixture-containing composition. Specifically, the Examiner is directed to the abstract which teaches "a vegetable-lipid based composition including a vegetable lipid component and a petroleum wax, wherein the composition contains a **greater concentration of the vegetable lipid component than the petroleum wax**" (*See*, column 1, at lines 6-10). Similarly, a *careful* reading of Claim 1 of Tao teaches "wherein said composition includes a **greater amount by weight of said free fatty acid/triglyceride mixture than said petroleum wax**" (*See*, column 7, at lines 53-56). Therefore, it follows that the petroleum wax must make up less than 50% by weight of Tao's candle compositions.

Likewise, Example 5 discloses that the "composition includes about 51% by weight to about 100% by weight of the fatty acid/triglyceride mixture and **up to about 49% by weight of the petroleum wax component**" (*See*, column 6, at lines 59-61). Applicants respectfully submit that the Examiner has misconstrued the teaching of Example 5 as reading upon the entire composition, as opposed to the fatty acid/triglyceride component. Specifically, Example 5 recites "[t]he **fatty acid/triglyceride mixture** can include about 1% by weight to about 99% by weight of the free fatty acid and about 1% by weight to about 90% by weight of the triglyceride" (*See*, column 6, at lines 64-67, emphasis added). Thus, Tao teaches compositions comprising 51-100% by weight lipid, which can be broken down into ~0.5-50.5% by weight triglyceride and ~0.5-50.5% by weight free fatty acid. Therefore, even if combined Tao, Sinwald and T1-foods fail to teach compositions comprising greater than 50% paraffin as required by amended Claims 1-26.

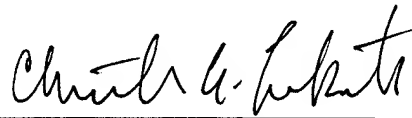
⁵ *See, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As a *prima facie* case of obviousness has not been established, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants believe that the amendments and arguments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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